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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,840	09/13/2000	Paul Remijan	2476.1003-001	7821
30407	7590	02/14/2006	EXAMINER	
BOWDITCH & DEWEY, LLP 311 MAIN STREET P.O. BOX 15156 WORCESTER, MA 01615-0156			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/660,840

Applicant(s)

REMIJAN ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, 22-33, 35-39, 51 and 59-69 is/are pending in the application.
- 4a) Of the above claim(s) 19-21, 34, 40-50, 52-58 and 70-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 22-33, 35-39, 51 and 59-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Objections***

1. Claims 33 and 63 objected to because of the following informalities: in claim 33, --layer—should be inserted after “absorbing”; in claim 63, line 3, “barriers” should be --barrier--  
Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 5, 6, 9, 12, 15, 17, 18, 22-26, 28-31, 35, 36, 39, 51 and 59-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. (U.S. Pat. 5,423,312) in view of Yoshida et al. (U.S. Pat. 4,593,973) and further in view of Kurtzer (U.S. Pat. 5,168,863).

Note reasons set forth in numbered paragraph 2 (second occurrence) of the previous Office Action, paper number 12282004. As to claims 1, 28, 51, note that optical element (5) in Siegmund, as previously referred to, is in fact a lens. As to amended claim 24, note elements (31) and (35) of Siegmund which connects a light source to the optical waveguide. As amended claim 25, these limitations were previously addressed with respect to claim 60. As to claims 63 and 64, as pointed out previously, the barrier is attached to the probe or probe element. The term “disposable” lends nothing to the claim since anything can be considered “disposable”.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Yoshida et al. and Kurtzer, and further in view of Woodard et al.. (U.S. Pat. 5,947,958)

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for the reasons set forth in numbered paragraph 3 of the previous Office Action, paper number 12282004.

5. Claims 7, 10, 13, 14, 16 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Yoshida et al. and further in view of Kurtzer for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 12282004.

6. Claims 8 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Yoshida et al. and Kurtzer, and further in view of Eastman (U.S. Pat. 5,319,731) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 12282004.

7. Claims 11, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Yoshida et al. and Kurtzer, and further in view of Strack (U.S. Pat. 3,902,880) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 12282004.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Yoshida et al. and Kurtzer and further in view of Jones (U.S. Pat. 3,724,922) for the reasons set forth in numbered paragraph 8 of the previous Office Action, paper number 12282004.

9. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Yoshida et al. and Kurtzer, and further in view of Kishi et al. (U.S. Pat. 4,972,827) for the reasons set forth in numbered paragraph 3 of the previous Office Action, paper number 12282004.

### *Response to Arguments*

10. Applicant's arguments filed December 5, 2005 have been fully considered but they are not persuasive.

Applicant argues that "The Office Action then seeks to combine known elements for larger diameter devices of standard size with the disclosure of Yoshida". The Examiner respectfully disagrees with this statement for a number of reasons. Firstly, if one refers to the rejection, the Examiner does NOT combine anything with the Yoshida et al. reference. Instead, a teaching from Yoshida et al. is used to show the level of ordinary skill when contemplating a diameter for the endoscope of Siegmund et al. Secondly, it is unclear why Applicant is assuming that the device disclosed by Siegmund et al. is in the group of "larger diameter devices of standard size". The disclosure of Siegmund et al. mentions nothing about size and is thus not limited to any particular size. This is where the level of ordinary skill in the art comes in as to what size a reasonable person would consider obvious. Thirdly, the proposed modification of Siegmund et al. in view of Yoshida et al. involves no swapping of structural elements, and especially no modification of the Yoshida et al. device with elements from the Siegmund et al. reference. The evidence provided by Yoshida et al. is only instrumental in showing what is known in the art with respect to typical sizes.

Although it is impossible to place any kind of objective definition to what is considered a “suitable image at *reasonable* cost”, Applicant at the least alleges that “it has not been known to successfully reduce the diameter of the components needed” to provide such image as such cost. However, Applicant has not provided any evidence to support such allegation. Even so, it is the Examiner’s position that such diameters (e.g., lens, waveguide) have been contemplated (note Tsuno et al. (U.S. Pat. 4,807,597) for example at col.10, lines 23-27). Other references showing the state of the art are cited below.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hicks (U.S. Pat. 5,425,123)—note col.3, lines 16-18.

Fitch (U.S. Pat. 5,919,128)—note col.3, lines 63-65.

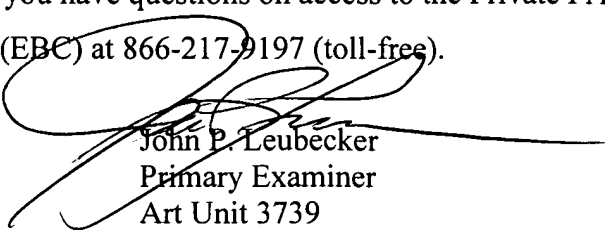
12. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739